

REMARKS

Reconsideration of this application is respectfully requested. Claims 7-9 are pending in the present application. Claims 7-9 stand rejected.

Claim Rejection – 35 U.S.C. §103

Claims 7-9 are rejected under 35 U.S.C. §103(a) as being unpatentable over applicants' admitted prior art Figs. 1-3 (APA, previously cited) in view of **Willner** (USP 5,790,103, previously cited). For the reasons set forth in detail below, this rejection is respectfully traversed.

The Office Action recognizes that **APA** does not disclose "a lowermost key array having a pair of left and right keys centrally juxtaposed in a home position for left and right thumbs of a user, one of the left and right keys being an ENTER/RETURN key and an uppermost key array having an extreme right key being a DELETE key, the ENTER/RETURN key, the SPACE key, the BACKSPACE key, and the DELETE key being a normal state of the keyboard without any key reassignment", and relies on **Willner** to teach these features. See Office Action, page 3, lines 7-14. As will be discussed in detail below, **Willner** does not disclose or suggest these claimed features and therefore does not alleviate the deficiencies of **APA**.

The keyboard disclosed by **Willner** is a new concept compact keyboard with having fewer keys, while still maintaining full size standard keys by comprising: a control key set (120) of control keys (122, 124, 126, 128, and 130); and, a character key set (220) of multifunction character keys (222, 224, 226, 228, and 230).

The control key set (120) of control keys (122, 124, 126, 128, and 130) should be operated by the left hand fingers of a user, and the character key set (220) of multifunction character keys (222, 224, 226, 228, and 230) should be operated by the right hand fingers together with simultaneous depression of a corresponding key of the control keys by the respective left hand finger.

Although Fig. 1B certainly shows an ENTER key (166) and a SPACE key (230) in a substantially juxtaposed manner, **the ENTER key (166) is not in the left hand thumb's home key**, while the SPACE key (230) is in the right hand thumb's home key position.

Contrary to the claimed invention, in the embodiment of Figs. 1B and 1C of **Willner**, **the home key (i.e., home position) for the left hand thumb is in a CAPS SHIFT key (162)**. More particularly, as described in column 6, lines 3 – 6, "The home keys of system 100 are identified by a triangularly shaped marking 142 on key 122, 144 on key 124, 146 on key 126, 148 on key 128 and 164 on key 162 for the left hand of the user."

Moreover, in the embodiment of Figs. 1B and 1C of **Willner**, the control key set (120) of control keys (122, 124, 126, 128 and 130) operated by the left hand fingers is wholly staggered in a perpendicularly upward direction with respect to the character key set (220) of multifunction character keys (222, 224, 226, 228 and 230) operated by the right hand fingers.

Thus, unlike the claimed invention the embodiment of Figs. 1B and 1C and the other embodiments of **Willner** do not disclose a centrally juxtaposed ENTER/SPACE key set operated by the left and right thumbs, an extreme right DELETE key in an uppermost key array, and an extreme right BACKSPACE key in a middle key array.

In the prior art shown in Fig. 3 of the present application, the centrally juxtaposed two keys in a lowermost array and downwardly protruding two keys are control keys operated by the left and right thumbs for selecting a required Japanese syllabic character in a respective multifunction character key, which control keys are required for the Japanese language word processing by a special thumb-shift style. It is respectfully submitted that it is impossible to replace these keys by other keys nor is it possible to rearrange these keys in a manner of the control key set (120) of control keys (122, 124, 126, 128, and 130) operated by the left hand fingers of **Willner**.

Further, in the prior art shown in Fig. 3 of the present application, **the "SPACE" key is not in the right hand thumb's home position, but is the next key thereto rightward.**

The prior art shown in each of Figs. 1 and 2 of the present application is a standard "QWERTY" keyboard and the art shown in Fig. 3 of the present application is substantially a standard "QWERTY" keyboard, in which each of character keys is allocated multi-functionally with two or three Japanese syllabic characters.

On the US (English) or Japanese standard "QWERTY" keyboard of the present invention the extreme right side position of the uppermost key array of the keyboard is a "DEL" rather than a conventional "BACKSPACE" key, and the extreme right side position of the middle key array is a "BACKSPACE" key rather than a conventional "ENTER" key, while an "ENTER" key is positioned in one of a thumb's home and a "SPACE" key is positioned in the other of thumb's home as a normal state.

Such a standard "QWERTY" keyboard has never been manufactured, and provides the advantage of favoring all people in the world with an easier character inputting operation without learning new operation as encountered in the **Willner** keyboard.

Accordingly, for the reasons set forth above, it is respectfully submitted that the combination of **APA** and **Willner** does not disclose or suggest all claimed elements, and the combination of **APA** and **Willner** does not result in the claimed invention. Reconsideration and withdrawal of the rejection of claims 7-9 are respectfully requested for at least the above reasons.

Further, applicants address below the *Response to Arguments* set forth in the last paragraph of Item 3 and in Item 4 of the Office Action. More specifically, the Examiner asserts:

The difference between the prior arts figures 1-3 and the instant inventions is rearranging some keys to provide better use of frequently used keys such as ENTER/RETURN key, the SPACE key, next to each other and both can be used with thumb.

It would be **design choice** to arrange the keyboard and provide the keyboard in different design. Also, since it has been held that rearranging parts of the invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

First, the Office Action has not addressed the patentability arguments provided in the previous response. Applicant calls the Examiner's attention to the Manual of Patent Examining Procedure §707.07, which requires that the Examiner's action should be complete as to all matters. Because the present Office Action has not addressed the previous patentability arguments, it is submitted that the Action is not complete. Accordingly, it is submitted that the previously presented patentability arguments are valid and are hereby incorporated by reference and reiterated.

Second, the Office Action characterizes the difference between the present invention and the prior art as “rearranging some keys to provide better use of frequently used keys....”. This characterization by the Examiner may be correct insofar as the present invention is an improved arrangement (or layout) of a keyboard. However, an improved arrangement of a keyboard (i.e., rearranging keys) is patentable if the new layout is novel (i.e., meets the requirements of §102) and unobvious (i.e., meets the requirements of §103).

The Office Action asserts that the presently claimed invention is obvious under §103, and supports the obviousness rejection by asserting (1) rearranging parts of the invention involves only routine skill in the art, citing *In re Japikse*, 86 USPQ 70, and (2) it would be **design choice** to arrange the keyboard and provide the keyboard in different design.

Neither of the reasons supporting the rejection is valid. Specifically, as discussed in the previous response, *In re Japikse* is not applicable because (1) *In re Japikse* applies to a situation wherein the **only** difference between the claimed invention and the prior art is a change in position of an element (i.e., a single element), and (2) the change in position would not have modified the operation of the prior art device. See discussion of *In re Japikse* starting at the bottom of page 7 of the previous response.

In this case, the Examiner admits that the change in position applies to more than just a single element, and the Examiner admits that the change in position modifies the operation of the device (i.e., the Examiner states “rearranging some keys to provide **better use of frequently used keys** such as ENTER/RETURN key, the SPACE key, next to each other and both can be used with thumb). Specifically, the Examiner admits that the improved layout of keys provides

“better use” of the keys. In other words, the change in position of the keys modifies the operation of the device, and therefore *In re Japikse* is not applicable.

Further, it is well established that a *prima facie* case of obviousness cannot be established by asserting that a claimed feature is a design choice. More specifically, it is well established that to establish a *prima facie* case of obviousness, evidenced motivation must be provided indicating why one skilled in the art would be motivated, lead, or suggested to modify an existing reference in view of another reference. In addition, it is *improper* to base a rejection on the claimed feature being merely a **design choice**. See *In re Garrett*, 1986 Pat. App. LEXIS 8 (Bd. Pat. App. 1986), where the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences (“Board”) specifically stated: “the examiner has not presented any line of reasoning as to why the artisan would have been motivated to so modify the...structure, and we know of none. The examiner’s assertion...that the proposed modification would have been “an obvious matter of engineering design choice well within the level of skill of one of ordinary skill in the art” is a conclusion, rather than a reason.” Similar discussions can be seen in *In re Chu*, 36 USPQ2d 1089 (Fed. Cir. 1985).

In this case, the Examiner has provided no line of reasoning as to why one of ordinary skill in the art would have been motivated to modify the references other than to conclude that (1) it is design choice, and (2) rearranging parts involves only routine skill in the art. Each of these reasons is improper for the reasons discussed above.

Accordingly, it is submitted that the Examiner has not established a *prima facie* case of obviousness. Therefore, it is respectfully submitted that the rejection under §103 is improper for all of the additional reason set forth above and should be withdrawn.

CONCLUSION

In view of the foregoing amendments and accompanying remarks, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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